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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/677,401

Filing Date: September 29, 2000

Appellant(s): KERN ET AL.

Reed R. Heimbecher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 5, 2007 appealing from the Office action mailed May 04, 2006

Art Unit: 3629

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 8-28, 30, 32-91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,345,261	FEIDELSON ET AL	9-1999
6,009,415	SHURLING ET AL	12-1991
6,119,933	WONG ET AL	9-2000

(4) "All Nippon Offering Special Awards To Frequent Flyers", Aviation Daily, Vol. 312, no. 11, (April 15, 1993), pp. 86.

(5) Bagot, B. "Lux in Flux", Marketing & Media Decisions, v25, n5 (May 1990), p87.

(6) "The GM Card Revs Its Engine in the United Kingdom", Credit Card News, (Nov. 1, 1993).

(9) Grounds of Rejection

The following ground(s) of rejections are applicable to the appealed claims.

Claim Status

Claims 8-28, 30, 32-91 are pending. They consist of 5 method (Mt) groups, (Mt¹) 8-28, 32-46, 90, (Mt²) 47-53, (Mt³) 54-64, 91, (Mt⁴) 65-70, and (Mt⁵) 71-89. Claims 1-7, 29, 31 have been cancelled.

NEW GROUND(S) OF REJECTION***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

Art Unit: 3629

thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-28, 30, 32-91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 8-28, 30, 32-91 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 3629

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 8-28, 30, 32-46 (method¹), 47-53 (method²), 54, (method³), 71-89 (method⁵) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref.¹) FEIDELSON et al in view of (Ref.²) SHURLING et al.**

Claim 8 is as followed:

8. (previously presented) A method of facilitating repayment of a loan obligation, said method comprising the steps of:

(A) a first party establishing a site on a global computer network;

(B) recognizing at least certain second-party users of said site by requiring said certain second-party users to provide initial registration information to become recognized second-party users, and requiring a first one of said recognized second-party users to provide additional registration information;

Art Unit: 3629

(C) directing said recognized second-party users to predetermined third-party merchants;

(D) enabling accumulation of loyalty points by said recognized second-party users based upon purchases from said predetermined third-party merchants;

(E) monitoring said purchases by said recognized second-party users from said predetermined third-party merchants;

(F) tracking said accumulated loyalty points; and

(G) said first party permitting said first one of said recognized second-party users to selectively repay the loan obligation based upon discretionary redemption of said accumulated loyalty points.

Note that the last critical step (G) only calls for "said first party permitting said first one recognized second-party user to ..." which basically calls for the first party to give permission to (or allowing) the 2nd party user to do something (selectively repay the loan obligation based upon discretionary redemption of said accumulated loyalty points).

The step of "the 2nd party user repaying the loan obligation" after receiving the permission from the first party is not positive claimed. Therefore, the step (G) is interpreted as the first party permitting (allowing) said first one recognized second-party user the intention to carry out the selectively repaying the loan obligation based upon discretionary redemption of said accumulated loyalty points. This is consistent throughout the other 4 independent claims, 47, 54, 65 and 71 "... permitting...".

Art Unit: 3629

As for Independent method claims 8 (method¹), 54 (method³), and 71 (method⁵), FEIDELSON et al fairly discloses a method of building personal financial assets by redeeming customer loyalty points comprising the steps of:

- (a) a 1st party (administrator) establishing a site on a global computer network {see Fig. 3, (300), Fig. 4};
- (b) recognizing at least certain users (2nd party) by requiring said certain 2nd party users to provide initial registration information to become recognized 2nd party users, and requiring a 1st one of the recognized 2nd party users to provide additional registration information {see Figs. 3, 4};
- (c.) directing the user to a predetermined 3rd party merchants (bank/store owner or 3rd party),
- (d) enabling accumulation of loyalty points by the user based upon transaction (service or purchase of product) from the predetermined merchant (bank/store),
- (e) monitoring the transaction/purchases by the users (2nd party) from the merchant (bank/store owner),
- (f) tracking the accumulated loyalty points {see Fig. 1 (3), col. 7, line 24 (or c7:24 for abbreviation), c9:23-27, 45-50}, and
- (g) permitting the user to redeem the loyalty points as monies "**rebate monies**" towards other products or services offered by merchants for customer's benefit, i.e. financial investment funds such as securities or shares of the stocks of the merchant, thus building personal financial assets/gains.

{see col. 1, lines 10-21 “... **The award points may then be redeemed towards other products or services offered by merchants.**”, col. 2, line 10 “... investing the rebates in the fund...”}.

FEIDELSON et al fairly teaches the claimed invention except for the intention of the 2nd party user to use a different type of redeeming product/service offered by the 3rd party merchant in step (G) after being permitted by the 1st party, reducing personal financial liability by repaying (or paying down or reducing) loan obligation.

In another method for improving customer relationship by encouraging more sale transactions with the customer, SHURLING et al discloses a merchant/bank service (or product or program) “Loyalty Banking Program” {see col. 1, lines 15-25, and 55-67} which provide opportunity of rewarding loyalty customers who have accumulated loyalty points/incentive rewards by exchanging the points/rewards with real money/financial values offered by the merchant/bank for customer's benefit such as by (1) reducing loan rate, (2) reducing bank service fee cost, or (3) increasing deposit account (CD) interest to the customer account, etc. (see col. 1, lines 30-65 (or 1:30-65), 2:10-15, 5: 1-5, 5:15-25, 9:15-20). Note that it's well known to a skilled artisan, a money manager or bank officer, that a personal loan normally include 3 variable: amount, rate and numbers (frequency) of payments (time). Therefore, the use of any of these 3 variables for affecting a loan obligation is well known and would have been obvious to a skilled artisan. For example, instead of reducing the rate, i.e. from 10.00% to 8.00%, the bank could reduce the number of payments from 60 payments (5 years for monthly payments) to 48 payments and achieve the same result. Alternatively, the bank could

reduce the balance one time and keep these other 2 variables the same to achieve the same results. Therefore, it would have been obvious for the banker to reduce the loan amount (or repaying the loan obligation) or number of payments as being equivalent item to reducing the loan rate to achieve similar result of reducing loan obligation, absent evidence of unexpected results.

It would have been obvious to a skilled artisan to modify the last step of **FEIDELSON et al** by using a different (other) type of product/service offered by the merchant/bank, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by **SHURLING et al** above as mere using other similar products or services or program offered by the merchant for customer's benefits, absent evidence of unexpected results.

As for dep. claim 9 (part of 8), the concept of tracking automatically is well known to improve efficiency and is taught on **FEIDELSON et al** c7:24, c9:23-27, 45-50, or **SHURLING et al** c8:59 or Fig. 4, (110).

As for dep. claims 10-11 (part of 8), these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and they are well known Internet communication steps and are taught in c9:40-67 of **FEIDELSON et al**.

As for dep. claims 12-14 (part of 8), which deals with the type of merchant and general Internet security parameters, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the

Art Unit: 3629

teachings of various merchants and products and services as indicated by FEIDELSON et al Fig. 1, 8, 9, a0a, 10b, Fig. 4., or SHURLING et al on col. 2, lines 5-15, col. 4, lines 20-50.

As for dep. claims 15-18 (part of 8), which deals with the general monitoring parameters by 3rd party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of FEIDELSON et al Fig. 1, col. 5, lines 5-65, or SHURLING et al col. 4, lines 20-50.

As for dep. claims 19-21, 27-28 (part of 8), which deals with the involvement of another broker merchant or 4th party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious as mere duplicate of duplicate of parts/services for multiple effects, see St. Regis Paper Co. vs. Bemis Co., 193 USPQ 8, 11; 549 F2d 833 (7th circ. 1977).

As for dep. claims 22-26 (part of 8), which deals the relationship between various parties, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the general teachings of FEIDELSON et al and SHURLING et al.

As for dep. claims 36-37 (part of 8), which deal with the type of connection to the merchant entrance, i.e. virtual shopping mall, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by

Art Unit: 3629

redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 1 or col. 5, lines 5-67.

As for dep. claims 38-43 (part of 8), which deal with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 3 or col. 5, lines 5-67 and SHURLING et al on col. 2, lines 10-30.

As for dep. claims 44-46 (part of 8), which deals again with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al col. 5, lines 5-67, SHURLING et al on col. 2, lines 10-30.

As for Independent method² claim 47, which has similar limitation as in independent method¹ claim 8 and further limitation of additional registration information, this is fairly taught in FEIDELSON et al col. 2, lines 45-67, col. 3, lines 45-55, SHURLING et al col. 4, lines 25-35. The additional of other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claim 48 (part of 47), which has similar limitation as in dep. claim 32, it's rejected for the same reason set forth in dep. claim 32 above.

As for dep. claim 49 (part of 47), these known variables are inherently included in the loan of SHURLING et al as shown on col. 5 and Tables A and B.

As for dep. claim 50 (part of 47), this is shown on cols. 10 and 11.

Art Unit: 3629

As for dep. claims 51, 53 (part of 47), the selection of the ratio of loyalty point to loan varies from bank to bank depends on the profit/cost structure and would have been obvious to a skilled artisan.

As for dep. claim 52 (part of 47), the selection of a 2nd loan service for the same purpose as in the 1st loan service would have been obvious as mere duplicate selection.

As for dep. claims 72-83 (part of 71), the provision of a screen providing a plurality of hyperlinks representing site contents are fairly discussed and shown on FEIDELSON et al col. 8, lines 60-67, col. 9, lines 15-50. Moreover, the selection of various hyperlinkages scenarios are considered as routine experimentations varying for each specific application and would have been obvious.

As for dep. claim 84 (part of 71), this is rejected over FEIDELSON et al as shown in Fig. 4, Fig. 5.

As for dep. claims 85-87, 89 (part of 71), they are rejected for the same reasons set forth in claims 10-11 above.

As for dep. claim 88 (part of 71), it's rejected for the same reason set forth in dep. claim 11 above.

6. **Dependent claim 30, 32-35, 90 (part of 8) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al / (Ref²) SHURLING et al as applied to claims 8-28 above, and further in view of (Ref³) ARTICLE 4/1993 (All Nippon ... Frequent Flyers).**

As for dep. claims 30, 90 (part of 8), in a similar method for redeeming loyalty points (bonus mileage credits), ARTICLE 4/1993 fairly discloses various options for redeeming points comprising a transfer from one user to another (2nd user) bonus mileage credits (or free ticket) to inherently allow the 2nd user to make effective use of the redeeming points as desired by the 1st user (see abstract). It would have been obvious to modify the process of FEIDELSON et al / SHURLING et al by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 as ways to consume the bonus or loyalty points as desired by the 1st user.

As for dep. claim 32 (part of 8), which deals with additional registration, this is fairly taught in FEIDELSON et al col. 2, lines 60-67, SHURLING et al col. 4, lines 25-35. The addition of other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claims 33-35 (part of 8), the limitations of the relationship between customer's loyalty points and merchant's sale price or commission vary with each circumstance and/or merchant's profit/cost structure and are considered as optimizing operating conditions or result effective parameters/variables and the optimizing of result effective variables is considered as **routine experimentation for different scenarios or programs** to determine optimum or economically feasible loyalty point redeeming or

exchanging conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

7. Dependent claims 55-62 (part of 54) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al in view of (Ref²) SHURLING et al as applied to claims 54 above, and further in view of (Ref⁴) WONG et al (US Patent 6,119,933).

As for dep. claim 55 (part of 54), the teachings of SHURLING et al. is cited above. In a similar method for redeeming loyalty points, WONG et al displaying information about the accumulated loyalty points to the user by categorizing the points with several status such as "new", "pending", "earned", etc, and displaying the points for each status (see col. 5, lines 45-60). It would have been obvious to modify the redeeming of loyalty points of FEIDELSON et al /SHURLING et al by categorizing the points according the status and displaying the points for each status as taught by WONG et al to inherently allow accurate monitoring and using of loyalty points program.

As for dep. claims 56-62 (part of 54), the various well known limitations with respect to loyalty points monitoring program such as waiting period, displaying of points, redeeming strategy, minimum point scale, etc., are fairly discussed in WONG et al as shown on pages 5-6.

Note: WONG et al also discloses the various steps of updating profiles and adding member and member transactions as shown on cols. 4-5.

Art Unit: 3629

8. **Claims 63-64, 91 (part of 8), 65-70 (method⁴) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al in view of (Ref²) SHURLING et al (Ref⁴) WONG et al as applied to claims 55-62 above, and further in view of (Ref³) ARTICLE 4/1993.**

As for claims 63, 91 (part of 8), 65 (method⁴), the teachings of FEIDELSON et al / SHURLING et al / WONG et al is cited above. The teaching of ARTICLE 4/1993 is cited above. It would have been obvious to modify the process of FEIDELSON et al / SHURLING et al in / WONG et al by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 so the 2nd user can user the loyalty points if desired by the 1st user.

As for dep. claim 64 (part of 54), the number of transfer point is considered routine experimentation varying with each business model and would have been obvious.

As for dep. claim 66 (part of 65), this is taught on WONG et al on cols. 4, 5, 6.

As for dep. claims 67-70 (part of 65), these are taught on WONG et al col. 5, lines 45-60.

Art Unit: 3629

9. **Claims 8-28, 30, 32-46 (method¹), 47-53 (method²), 54, (method³), 71-89 (method⁵) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over (Ref.¹) FEIDELSON et al in view of "GM Card" Article (Nov. 1993) and "LUX in FLUX" Article (May 1990).**

The teachings of FEIDELSON et al is cited above.

In another method for improving customer relationship by encouraging more sale transactions with the customer, GM Card Article discloses the use of loyalty points (5% of charge volume on the card) being redeemable for rebates of the purchase price of a car or van or as cash at shops {see page 1, 4th and 6th paragraphs}. "LUX in FLUX" Article is merely cited to teach (1) well known fact of obtaining of a new car is done by leasing or by obtaining a loan through the car company's credit corporation (i.e. General Motors Corp.) and (2) wherein customer can redeem loyalty points (frequent-flier miles) toward the purchase of a car {see page 2, 6th paragraph}. In other word, if the user has an amount of credit or loyalty points (1,000\$ equivalent) and the purchase price (or loan amount) of the car initially is (\$15,000), then this would reduce the purchase price or loan amount to \$14,000.00. It would have been obvious to a skilled artisan to modify the last step of FEIDELSON et al by using a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by "GM Card" Article and "LUX in FLUX" Article.

As for dep. claim 9 (part of 8), the concept of tracking automatically is well known to improve efficiency and is taught on FEIDELSON et al c7:24, c9:23-27, 45-50.

Art Unit: 3629

As for dep. claims 10-11 (part of 8), these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and they are well known Internet communication steps and are taught in c9:40-67 of FEIDELSON et al or "GM Card Article" and "LUX in FLUX" Article above.

As for dep. claims 12-14 (part of 8), which deals with the type of merchant and general Internet security parameters, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of various merchants and products and services as indicated by FEIDELSON et al Fig. 1, 8, 9, a0a, 10b, Fig. 4.

As for dep. claims 15-18 (part of 8), which deals with the general monitoring parameters by 3rd party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of FEIDELSON et al Fig. 1, col. 5, lines 5-65.

As for dep. claims 19-21, 27-28 (part of 8), which deals with the involvement of another broker merchant or 4th party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious as mere duplicate of duplicate of parts/services for multiple effects, see St. Regis Paper Co. vs. Bemis Co., 193 USPQ 8, 11; 549 F2d 833 (7th circ. 1977).

As for dep. claims 22-26 (part of 8), which deals the relationship between various parties, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the general teachings of FEIDELSON et al and "GM Card" Article and "LUX in FLUX" Article.

As for dep. claims 36-37 (part of 8), which deal with the type of connection to the merchant entrance, i.e. virtual shopping mall, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 1 or col. 5, lines 5-67.

As for dep. claims 38-43 (part of 8), which deal with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 3 or col. 5, lines 5-67.

As for dep. claims 44-46 (part of 8), which deals again with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al col. 5, lines 5-67, and "GM Card" Article and "LUX in FLUX" Article above.

As for Independent method² claim 47, which has similar limitation as in method¹ claim 8 and further limitation of additional registration information, this is fairly taught in FEIDELSON et al col. 2, lines 45-67, col. 3, lines 45-55. The additional of

other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claim 48 (part of 47), which has similar limitation as in dep. claim 32, it's rejected for the same reason set forth in dep. claim 32 above.

As for dep. claims 49-50 (part of 47), these known variables are inherently included in the loan "GM Card" Article and "LUX in FLUX" Article.

As for dep. claims 51, 53 (part of 47), the selection of the ratio of loyalty point to loan varies from bank to bank depends on the profit/cost structure and would have been obvious to a skilled artisan.

As for dep. claim 52 (part of 47), the selection of a 2nd loan service for the same purpose as in the 1st loan service would have been obvious as mere duplicate selection.

As for dep. claims 72-83 (part of 71), the provision of a screen providing a plurality of hyperlinks representing site contents are fairly discussed and shown on FEIDELSON et al col. 8, lines 60-67, col. 9, lines 15-50. Moreover, the selection of various hyperlinkages scenarios are considered as routine experimentations varying for each specific application and would have been obvious.

As for dep. claim 84 (part of 71), this is rejected over FEIDELSON et al as shown in Fig. 4, Fig. 5.

As for dep. claims 85-87, 89 (part of 71), they are rejected for the same reasons set forth in claims 10-11 above.

As for dep. claim 88 (part of 71), it's rejected for the same reason set forth in dep. claim 11 above.

Art Unit: 3629

10. Dependent claim 30, 32-35, 90 (part of 8) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article as applied to claims 8-28 above, and further in view of ARTICLE 4/1993 (All Nippon ... Frequent Flyers).

As for dep. claims 30, 90 (part of 8), in a similar method for redeeming loyalty points (bonus mileage credits), ARTICLE 4/1993 fairly discloses various options for redeeming points comprising a transfer from one user to another (2nd user) bonus mileage credits (or free ticket) to inherently allow the 2nd user to make effective use of the redeeming points as desired by the 1st user (see abstract). It would have been obvious to modify the process of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 as ways to consume the bonus or loyalty points as desired by the 1st user.

As for dep. claim 32 (part of 8), which deals with additional registration, this is fairly taught in FEIDELSON et al col. 2, lines 60-67. The addition of other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claims 33-35 (part of 8), the limitations of the relationship between customer's loyalty points and merchant's sale price or commission vary with each circumstance and/or merchant's profit/cost structure and are considered as optimizing operating conditions or result effective parameters/variables and the optimizing of result effective variables is considered as **routine experimentation for different scenarios** or

programs to determine optimum or economically feasible loyalty point redeeming or exchanging conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

11. Dependent claims 55-62 (part of 54) are rejected under 35 U.S.C. 103(a) as being unpatentable over FEIDELSON et al in view of "GM Card" Article and "LUX in FLUX" Article as applied to claims 54 above, and further in view of (Ref⁴) WONG et al (US Patent 6,119,933).

As for dep. claim 55 (part of 54), the teachings of SHURLING et al / "GM Card" Article and "LUX in FLUX" Article is cited above. In a similar method for redeeming loyalty points, WONG et al displaying information about the accumulated loyalty points to the user by categorizing the points with several status such as "new", "pending,", "earned", etc, and displaying the points for each status (see col. 5, lines 45-60). It would have been obvious to modify the redeeming of loyalty points of FEIDELSON et al /"GM Card" Article and "LUX in FLUX" Article by categorizing the points according the status and displaying the points for each status as taught by WONG et al to inherently allow accurate monitoring and using of loyalty points program.

As for dep. claims 56-62 (part of 54), the various well known limitations with respect to loyalty points monitoring program such as waiting period, displaying of points, redeeming strategy, minimum point scale, etc., are fairly discussed in WONG et al as shown on pages 5-6.

Note: WONG et al also discloses the various steps of updating profiles and adding member and member transactions as shown on cols. 4-5.

12. Claims 63-64, 91 (part of 8), 65-70 (method⁴) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over FEIDELSON et al in view of "GM Card" Article, "LUX in FLUX" Article, WONG et al as applied to claims 55-62 above, and further in view of (Ref³) ARTICLE 4/1993.

As for claims 63, 91 (part of 8), 65 (method⁴), the teachings of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article / WONG et al is cited above. The teaching of ARTICLE 4/1993 is cited above. It would have been obvious to modify the process of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article / WONG et al by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 so the 2nd user can user the loyalty points if desired by the 1st user.

As for dep. claim 64 (part of 54), the number of transfer point is considered routine experimentation varying with each business model and would have been obvious.

As for dep. claim 66 (part of 65), this is taught on WONG et al on cols. 4, 5, 6.

As for dep. claims 67-70 (part of 65), these are taught on WONG et al col. 5, lines 45-60.

(10) Response to Argument

In response to applicant's majority of arguments about "against the references individually", one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

1) Applicant's arguments on pages 15-17 that FEIDELSON et al is directed toward a customer loyalty investment program, a forced investment program, and that there is no connection to the next step of redeeming the loyalty points for repaying the loan obligations are not persuasive for the following reasons:

(a) As discussion in the interpretation of the last step (G) as shown on pages 5-6 above, "repay the loan obligation" is merely intention of the user/consumer to do it. There is no positive recitation step of the user "repaying the loan obligation" so the intention phrase in current step (G) may not have any patentable weight.

(b) FEIDELSON et al fairly taught in col. 1, lines 10-21 "***The award points may then be redeemed towards other products or services offered by merchants.***" for rewarding the customer to inherently improve relationship for being loyalty and for making additional purchase, therefore, in view of this main teachings, redeeming the loyalty points for investing the rebates in the fund is merely just using a type of product or service offered by the merchant. FEIDELSON et al is not teaching that investing in the fund is the only way for redeeming loyalty points and the merchant has no other products or services.

2) Applicant's arguments on pages 18-19 with respect to SHURLING et al is noted, however, they are not found persuasive because:

(a) as cited above, the phrase , "repay the loan obligation" is merely intention of the user/consumer to do it. There is no positive recitation step of the user "repaying the loan obligation" so the intention phrase in current step (G) may not have any patentable weight.

(b) "repay the loan obligation" is one of the service offered by the merchant/bank to improve relationship with the customer for being loyalty, see SHURLING et al col. 1, lines 5-40, and therefore, it would have been obvious to redeem award points toward any other well known products or services offered by the merchants such as disclosed by SHURLING et al in FEIDELSON et al as merely using other well known products or services by the merchaarnts.

(c) Moreover, Appellant's pre-KSR arguments that there is no teaching suggestion or motivation to combine SHURLING et al with FEIDELSON et al, this is not persuasive because KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S. Ct. FEIDELSON et al 1741, 82 USPQ2d at 1396.

3) Applicant's arguments on pages 20-22 with respect to the 3-parties relationship is noted however they are not found to be persuasive because this concept is fairly taught in FEIDELSON et al. and SHURLING et al is not used to show or relate to this teaching. SHURLING et al is merely cited for the teaching of "repay the loan

Art Unit: 3629

obligation" is one of the service offered by the merchant/bank to improve relationship with the customer for being loyalty.

4) Applicant's arguments on pages 23-26 with respect to SHURLING et al is noted, however, they are not found persuasive because:

(a) as cited above, the phrase , "repay the loan obligation" is merely intention of the user/consumer to do it. There is no positive recitation step of the user "repaying the loan obligation" so the intention phrase in current step (G) may not have any patentable weight.

(b) "repay the loan obligation" is one of the service offered by the merchant/bank to improve relationship with the customer for being loyalty, see SHURLING et al col. 1, lines 5-40, and therefore, it would have been obvious to redeem award points toward any other well known products or services offered by the merchants such as disclosed by SHURLING et al in FEIDELSON et al as merely using other well known products or services by the merchants.

(c) Moreover, Appellant's pre-KSR arguments that there is no teaching suggestion or motivation to combine SHURLING et al with FEIDELSON et al, this is not persuasive because KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S. Ct. FEIDELSON et al 1741, 82 USPQ2d at 1396.

(d) Applicant's argument that SHURLING et al fails to teach this specific limitation or repaying loan obligation is noted, however, this is argument against the reference individually, since this notation has been mentioned by the examiner on page

Art Unit: 3629

4, last paragraph, and the reason for reducing the loan amount would have been obvious to a skilled artisan as mentioned on page 5, 1st paragraph. Note that it's well known to a skilled artisan, a money manager or bank officer, that a personal loan normally include 3 variable: amount, rate and numbers (frequency) of payments (time). Therefore, the use of any of these 3 variables for affecting a loan obligation is well known and would have been obvious to a skilled artisan. For example, instead of reducing the rate, i.e. from 10.00% to 8.00%, the bank could reduce the number of payments from 60 payments (5 years for monthly payments) to 48 payments and achieve the same result. Alternatively, the bank could reduce the balance one time and keep these other 2 variables the same to achieve the same results. Therefore, it would have been obvious for the banker to reduce the loan amount (or repaying the loan obligation) or number of payments as being equivalent item to reducing the loan rate to achieve similar result of reducing loan obligation, absent evidence of unexpected results. Therefore, it would have been obvious to a skilled artisan to modify the last step of FEIDELSON et al by using a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by SHURLING et al above, absent evidence of unexpected results.

5) Applicant's comments on pages 27-28 have been reviewed but are not persuasive since these are merely applicant's objective comments and not subjective arguments and these issues have been addressed in the rejections of the dependent claims as cited above.

Art Unit: 3629

6) Applicant's comments on pages 28-32, 36-37, and 39-42 have been reviewed but are not persuasive since these are merely repeating arguments of FEIDELSON et al with other references, "GM Card" and "LUX in FLUX" which has similar teachings to SHURLING et al, for the same reasons set forth in the responses to arguments shown in item (2) above to avoid repeated copying of the same rebuttal information.

7) Applicant's comments on pages 39-41 with respect to the additional references of Wong and Article 4/1993 have been reviewed but are not persuasive since these are merely applicant's opinions. These specific teachings in argument are taught in Wong and Article 4/1993 as shown on pages 13-14, 19-21 above.

8) Applicant's comments on pages 33-35, and 38-39 have been reviewed but are not persuasive since these are merely repeating of the main arguments of combination of FEIDELSON et al with SHURLING et al, these have been addressed in items 1) and 2) and 4) above to avoid repeated copying of the same rebuttal information.

9) Applicant's comments with respect to the rejections of the dependent claims are noted and that they depend on the rejections of the independent claims or mostly FEIDELSON et al /SHURLING et al with respect to the main argument of "repaying the loan obligation" are noted. However, these issues with the independent claims have been addressed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Art Unit: 3629

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689

Conferees:

/Jan Mooneyham/
Supervisory Patent Examiner, Art Unit 3689

/Vincent Millin /
Appeals practice Specialist



A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



WILLIAM W. COGGINS
TECHNOLOGY CENTER DIRECTOR